

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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|-------------------------------|---|--|
| Applicant: Daniel A. Hilbrich | ) | For: Filtering Device for an Espresso- |
|                               | ) | Type Coffee Maker                      |
|                               | ) |  |
| Serial No. 10/047,852         | ) | Group Art Unit: 3742                   |
|                               | ) |  |
| Filed: January 15, 2002       | ) | Examiner: Reginald L. Alexander        |
|                               | ) |  |
|                               | ) | Confirmation No. 5104                  |

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The applicant hereby requests that a panel of examiners formally review the legal and factual bases of the rejections in the above-referenced application prior to the filing of an appeal brief. The applicant respectfully submits that the rejections are legally and factually inadequate for the reasons concisely described herein.

The obviousness rejections of all pending claims 1-8, 10-12, 14-21, and 23-28 are legally and factually inadequate, and therefore a proper obviousness analysis was not performed. In particular, the stated reasoning advanced by the Office both for making and upholding the proposed combination of references is flawed. Moreover, an incorrect legal standard was applied in sustaining the proposed combination of references cited against the pending claims.

Submitted herewith is a Notice of Appeal and the requisite fee.

**CLAIM REJECTIONS – 35 U.S.C. § 103**

Claims 1-8, 10-12, 14-21, and 23-28 are pending. Claims 1, 4, 5, 7, 8, 10-12, 14-18, 21, 23-25, 27, and 28 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,403,605 ("Smith") in view of U.S. Patent No. 5,490,447 ("Giuliano"). Claims 2, 3, 6, 19, 20, and 26 were rejected under 35 U.S.C. § 103(a) as obvious over Smith in view of Giuliano and further in view of U.S. Patent No. 4,052,318 ("Krebs").

The applicant respectfully submits that there is no motivation to combine Smith and Giuliano as proposed by the examiner for at least the following reasons.

Giuliano discloses an automatic espresso and cappuccino machine that filters the espresso-type coffee through a single filter disk having openings with a diameter of about 0.3 mm. Giuliano does not disclose or suggest filtration of espresso-type coffee ground through both a paper filter and a permanent filter as recited in the claimed invention.

Smith discloses a coffee brewer that includes a filter element 42 and a foraminous support sheet 44, which offers strength to support the filter element 42. Smith, col. 4, lines 38-41. The official action dated February 13, 2008, mischaracterizes Smith when it states that “while Smith discloses element 44 as a ‘foraminous support’, such functions as a filtering element.” Official Action, page 2. The coffee being filtered in Smith has “a grind with an average particles size within a range from 300 to 850 microns,” while the foraminous support sheet 44 has openings with a diameter of 1 mm to 2.5 mm. Smith col. 3, lines 30-33, and U.S. Patent No. 5,190, 653 (“Herrick”), col. 3, lines 29-30. (Smith expressly incorporates the disclosure of Herrick by reference. See Smith col. 2, lines 66-68, to col. 3, lines 1-2.). The coffee grind particles would pass through the foraminous support sheet 44. Thus, the foraminous support sheet 44 **cannot** function as a **filtering element** within the meaning of the claims, which call for a filter element “sized to filter coffee grounds having a size of 0.3 mm or less” or equivalent language. Accordingly, both Smith and Giuliano fail to disclose or suggest the combined use of a permanent filter and a paper filter for any reason, much less in order to reduce the lipid content of the brewed coffee.

Furthermore, Smith expressly teaches that the foraminous support sheet 44 is intended to function as a support for a filtering element 42. See Smith, col. 4., lines 38-41. Consistent with this function and the goal of “providing a process for rapidly brewing coffee,” Smith discloses that the foraminous support sheet 44 have openings with a diameter from 1 mm to 2.5 mm and that it should contain the maximum open area consistent with strength. Smith, col. 2, lines 14-18; and Herrick, col. 3, lines 22-23, and lines 29-30. Accordingly, one of ordinary skill in the art would not be motivated to modify Smith to reduce the size of the openings of the foraminous support because such a reduction in the opening size is contrary to the

express teachings in Smith that the foraminous support sheet 44 openings have a diameter of 1 mm to 2.5 mm and that the foraminous support sheet 44 contain the maximum open area consistent with strength.

Clearly, Smith teaches away from the invention. As a result one of ordinary skill in the art would not be motivated to combine Smith with Giuliano or any other reference teaching a filter having openings sized to filter coffee grounds of a size of 0.3 mm or less. Moreover, neither Smith nor Giuliano teaches or suggests filtration of espresso-type coffee through both a paper filter and a permanent filter as recited in the claimed invention. Therefore, a *prima facie* case of obviousness cannot be based on the combination of Smith and Giuliano as suggested by the examiner.

The applicant respectfully submits that the obviousness rejections of claims 1-8, 10-12, 14-21, and 23-28 should be withdrawn in view of the above remarks.

#### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that all pending claims 1-8, 10-12, 14-21, and 23-28 are in condition for allowance.

May 13, 2008

Respectfully submitted

By: \_\_\_\_\_

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